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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
2645	7

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,006

Applicant(s)

I'ANSON, COLIN

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on February 13, 2004. **Claims 1-20** are now pending in the present application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11-13,15,18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "without a call being made from the mobile entity raises new matter issues since the originally filed specifically appears to not disclose of the ability to not make a call from the mobile entity for receiving the data message.
4. The amendment filed February 13, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "without a call being made from the mobile unit.". If applicant believes that this limitation was supported by the original specifically then the Examiner respectfully asks applicants to specifically point out where the citing of "a call not being made from the mobile unit" is disclosed.

Applicant is required to cancel the new matter in the reply to this Office Action.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. US Patent 6,219,694 in view of Shaffer US Patent 6,021,114 and further in view of Brilla et al. US Patent 6,389,276.

Regarding claim 1, Lazaridis teaches a method of transferring audio messages (voice message) to a mobile entity (24) across a mobile radio infrastructure (20), (abstract; fig. 1; col. 3, lines 36-43; col. 6, lines 20-48; col. 7, lines 57-65), the method comprising the steps of:

(a) transferring to a service system a voice call made towards the mobile entity, (col. 5, lines 37-50; col. 6, lines 7-48; col. 18, lines 5-10); and

(b) forming it into a data message addressed to the mobile entity, (col. 6, lines 20-48; col. 8, lines 32-55; the voice message is formed as an attachment to an e-mail message); and

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(d) storing the data message in the mobile entity (24) for subsequent access by a user, (col. 8, lines 48-55).

Lazaridis does not specifically teach of passing the data message to the mobile entity at a time determined with a view to avoid peak traffic.

In the same field of endeavor, Shaffer teaches of sending messages over a data-capable bearer service of a wireless radio infrastructure (col. 4, lines 35-48; the communication medium that the message is sent over can be a wireless infrastructure) and at a time determined with a view to avoiding peak traffic loading of the radio infrastructure, passing the data message to the mobile entity over a data-capable bearer service of the radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35; col. 7, lines 9-22; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

While Lazaridis and Shaffer teach of receiving a voice message and since it was well known in the art that voice messages are left for a voice message subscriber by calling a subscriber of the voice message service and receiving a busy or no answer condition which will prompt the voice message system to request a message to be left (well known voice messaging system features for uncompleted calls), Lazaridis and Shaffer do not specifically teach of transferring to a service system a voice call made towards the mobile entity which cannot be completed and recording the call at the service system.

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In the same field of endeavor, Brilla teaches that it was well known in the art to transfer audio message to a mobile entity across a mobile radio infrastructure, (abstract) and transferring to a service system a voice call made towards the mobile entity but which cannot be completed (col. 4, lines 28-35) and recording the call at the service system, (col. 4, lines 33-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis and Shaffer by receiving and recording a voice message in response to an uncompleted call as taught by Brilla so that caller can leave important messages for the subscriber if the subscriber was not reached.

Regarding claim 2, Lazaridis as modified by Shaffer and further modified by Brilla and as applied to claim 1, teaches of transferring an audio message to a mobile entity at a time determined with a view to avoid traffic. Lazaridis, however, does not teach of passing the message at a time corresponding to an off-peak charging rate.

However, as shown above, Shaffer teaches wherein the data message is passed to the mobile entity at a time corresponding to an off-peak charging rate through the mobile radio infrastructure (col. 4, lines 35-48) according to a predetermined tariff schedule held or accessed by the service system, (computer network server), (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 3, Lazaridis as modified by Shaffer and further modified by Brilla and as applied to claim 1, teaches of transferring an audio message to a mobile entity at a time determined with a view to avoid traffic. Lazaridis, however, does not teach of passing the data message at a time corresponding to an off-peak time according to the loading of the mobile radio infrastructure.

However, as shown above, Shaffer teaches wherein the data message is passed to the mobile entity (col. 4, lines 35-48) at a time corresponding to an off-peak charging rate through the mobile radio infrastructure according to a charging schedule dynamically changed to take account of the actual loading of the mobile radio infrastructure, this schedule being accessed at least periodically by the service system, (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 4, Lazaridis as modified by Shaffer and further modified by Brilla and as applied to claim 1, teaches of transferring an audio message to a mobile entity at a time determined with a view to avoid traffic. Lazaridis, however, does not teach of wherein the data message is passed to the mobile entity at a time preset according to a schedule.

Shaffer teaches wherein the data message is passed to the mobile entity at a time preset according to a schedule agreed with the operator of the mobile radio infrastructure for avoiding peak load periods on the infrastructure, (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 5, Lazaridis as modified by Shaffer and further modified by Brilla and as applied to claim 1, teaches of transferring an audio message to a mobile entity at a time determined with a view to avoid traffic. Lazaridis, however, does not teach wherein the data message is passed to the mobile entity at a time negotiated with an arbitration system.

Shaffer teaches wherein the data message is passed to the mobile entity at a time negotiated with an arbitration system in communication with the mobile radio infrastructure, to satisfy transfer parameters specified by the service system for transfer of the data message through the mobile radio infrastructure, (col. 2, lines 6-17; col. 3, lines 8-45; col. 2, lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 6, Lazaridis, as applied to claim 1, teaches wherein the data message is passed to the mobile entity in response to the mobile radio infrastructure indicating to the service system that the mobile entity is available to receive the data message, (col. 8, lines 32-55).

Regarding claim 8, Lazaridis, as applied to claim 1, teaches including supplying the service system with a called party ID identifying the mobile device in response to transfer of the voice call to the service system by looking up a destination address for the data message in response to the called party ID, (col. 8, lines 32-55).

Regarding claim 9, Lazaridis, as applied to claim 1, teaches wherein the data message is an e-mail message, (col. 8, lines 32-55).

Regarding claim 10, Lazaridis, as applied to claim 8, teaches wherein the service system performs the looking up step, (col. 8, lines 32-55).

8. Claims 11-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brilla in view of Lazaridis.

Regarding claim 11, Brilla teaches a method of transferring an audio message to a mobile entity across a mobile radio infrastructure, (abstract), the method comprising the steps of:

(a) transferring to a service system an uncompleted voice call made towards the mobile entity, (col. 4, lines 28-35),

(b) forming the uncompleted call into a data message addressed to the mobile entity, (col. 4, lines 33-39); and

(c) subsequently passing the data message to the mobile entity over a data-capable bearer service of the mobile radio infrastructure, (col. 4, lines 39-45; col. 6, lines 3-15).

While Brilla teaches of passing the data message to the mobile entity, Brilla does not specifically teach of passing the data message without a call being made from the mobile entity.

Lazaridis teaches that it was well known in the art to receive a voice message and to form the voice message into a data message addressed to the mobile entity and to pass the data

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message to the mobile entity over a data-cable bearer service of the mobile radio infrastructure without a call being made from the mobile entity, (col. 8, lines 32-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the message without making a call from the mobile entity as taught by Lazaridis so that that the user can avoid having to poll the service center by calling in order to have the message delivered.

Regarding claim 12, Brilla, as applied to claim 11, does not specifically teach of storing the data message in the mobile entity.

Lazaridis teaches storing the data message in the mobile entity for subsequent access by a user, (col. 8, lines 48-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by storing the data message in the mobile entity so that the user can avoid having to poll the service center by calling and can immediately review the message.

Regarding claim 13, Brilla, as applied to claim 12, teaches wherein the call is formed into the data message at the service system and the data message is passed from the service system to the mobile entity, (col. 4, lines 28-35).

Regarding claim 19, Brilla teaches an apparatus for enabling an audio message to be transferred to a mobile entity across a mobile radio infrastructure (abstract) comprising:

a receiver for an uncompleted voice call made towards the mobile entity, (col. 4, lines 28-35);

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a process for forming the uncompleted call into a data message addressed to the mobile entity, (col. 4, lines 33-39); and

a memory for storing the data message, (col. 4, lines 33-39).

While Brilla teaches of passing the data message to the mobile entity, Brilla does not specifically teach of passing the data message without a call being made from the mobile entity.

Lazaridis teaches that it was well known in the art to receive a voice message and to form the voice message into a data message addressed to the mobile entity and a transmitter for retrieving the message and transmitting the data message to the mobile entity over a data-cable bearer service of the mobile radio infrastructure without a call being made from the mobile entity, (col. 8, lines 32-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the message without making a call from the mobile entity as taught by Lazaridis so that the user can avoid having to poll the service center by calling in order to have the message delivered.

9. Claims 14-16, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brilla et al. US Patent 6,389,276 in view of Shaffer et al. US Patent 6,021,114

Regarding claim 14, Brilla, teaches a method of transferring an audio message to a mobile entity across a mobile radio infrastructure, (abstract), the method comprising the steps of:

(a) transferring to a service system an uncompleted voice call made towards the mobile entity, (col. 4, lines 28-35),

(b) forming the uncompleted call into a data message addressed to the mobile entity, (col. 3, lines 33-39); and

(c) subsequently passing, the data message to the mobile entity over a data-capable bearer service for the mobile radio infrastructure, (col. 4, lines 39-45; col. 6, lines 3-15).

Brilla does not specifically teach at a non-peak traffic loading time of the mobile radio infrastructure passing the data message to the mobile entity.

Shaffer teaches of sending messages over a data-capable bearer service of a wireless radio infrastructure and at a time determined with a view to avoiding peak traffic loading of the radio infrastructure, passing the data message to the mobile entity over a data-capable bearer service of the radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 15, Brilla, as applied to claim 14, does not teach wherein the passing step is performed without a call being made.

Shaffer teaches wherein the passing step is performed without a call being made from the mobile entity, (col. 4, lines 35-48; col. 3, lines 18-35; the message is sent directly to the destination).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the message without making a call from the mobile entity as taught by Shaffer so that that the user can avoid having to poll the service center by calling in order to have the message delivered.

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Regarding claim 16, Brilla, as applied to claim 11, does not teach of passing the message at a non-peak time.

Shaffer, as applied above, teaches wherein the passing step is performed at a non-peak traffic loading time of the mobile radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 17, Brilla teaches an apparatus for enabling an audio message to be transferred to a mobile entity across a mobile radio infrastructure (abstract) comprising:

a receiver for an uncompleted voice call made towards the mobile entity, (col. 4, lines 28-35);

a processor for forming the uncompleted call into a data message addressed to the mobile entity, (col. 4, lines 33-39);

a memory for storing the data message, (col. 4, lines 33-39).

Brilla does not specifically teach at a non-peak traffic loading time of the mobile radio infrastructure passing the data message to the mobile entity.

Shaffer teaches of a transmitter for sending messages over a data-capable bearer service of a wireless radio infrastructure and at a time determined with a view to avoiding peak traffic loading of the radio infrastructure, passing the data message to the mobile entity over a data-

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capable bearer service of the radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

Regarding claim 18, Brilla, as applied to claim 17, does not specifically teach wherein the transmitter is arranged for transmitting the retrieved stored data message without a call being received by the apparatus from the mobile entity.

Shaffer teaches wherein a transmitter is arranged to transmit the stored data message without a call being made from the mobile entity, (col. 4, lines 35-48; col. 3, lines 18-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the message without making a call from the mobile entity as taught by Shaffer so that that the user can avoid having to poll the service center by calling in order to have the message delivered.

Regarding claim 20, Brilla, as applied to claim 17, does not specifically teach wherein the transmitter is arranged for transmitting the retrieved stored data message during non-peak traffic loading time of the mobile radio infrastructure.

Shaffer, as applied above, teaches wherein a transmitter is arranged for transmitting the stored data message during non-peak traffic loading time of the mobile radio infrastructure, (col. 4, lines 35-48; col. 3, lines 18-35).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brilla by sending the data message to the mobile entity at a time determined with a view to avoid peak traffic as taught by Shaffer so that the cost of sending a message can be reduced and so that traffic congestion in the network can be reduced.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. US Patent 6,219,694 in view of Shaffer et al. US Patent 6,021,114 and further in view of Brilla et al. US Patent 6,389,276 in view of in view of Hickman US Patent Pub. 2001/0033564.

Regarding claim 7, while Lazaridis, Shaffer and Brilla, as applied to claim 1, teach of sending the voice call as a data message to the mobile entity, they do not specifically teach of converting the voice call to text.

Hickman teaches wherein voice call is converted to text at the service system for incorporation into the data message, (paragraph 75). The system of Hickman teaches the voice message can be converted to text and incorporated into an e-mail message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lazaridis and Shaffer by converting the voice call to text so that the called party can read the contents of the voice call.

Response to Arguments

11. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any response to this action should be mailed to:

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The
examiner can normally be reached on M-F (6:30AM - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ovidio Escalante
Examiner
Group 2645
May 3, 2004

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante